

REMARKS

This Amendment is submitted simultaneously with filing of a Request for Continuing Examination.

The Examiner's indication of allowance of Claim 26 has been gratefully acknowledged, and this claim has been retained as it was.

In connection with the Examiner's rejection of the claims, applicants amended Claim 13, the broadest claim on file.

It is respectfully submitted that the new features of the present invention as defined in Claim 13 clearly and patentably distinguish the present invention from the prior art applied by the Examiner.

The patent to Wohlwend applied by the Examiner against the claims discloses a device in which, in contrast to the applicant's invention, the type of mounting of the tool holder is different from that disclosed in the present application. In particular, the mounting of the tool holder in the reference is performed tangentially without openings in the tool holder, as can be seen from Figure 3b of the patent application.

The present invention is also different from the prior art is in the overlapping length between the tool holder and the drive tube. The overlapping length shown in Figure 2 of the reference is insufficient for a reliable guidance with efficient sliding fit.

Claim 13 has been amended to more clearly define the present invention and to distinguish from the prior art represented by this reference.

First of all it is stated that a locking element (24) is oriented in a direction perpendicular to the sliding feet (18). Then it is stated that the locking element is introduced into bore holes provided in the tool holder and in the drive tube in alignment with one another.

It is believed to be clear that the new features of the present invention as now defined in Claim 13 are not disclosed in the reference applied by the Examiner.

The Examiner rejected the claims over this reference as being anticipated. In connection with this, it is believed to be advisable to cite the decision In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Wohlwend does not disclose each and every element of the present invention as now defined in amended Claim 13.

Also, as explained hereinabove, the present invention provides for highly advantageous results in obtaining a reliable sliding fit between the corresponding elements of the device. It is well known that in order to support a valid rejection in the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

It is therefore respectfully submitted that Claim 13 should be considered as patentably distinguishing over the art and should be allowed.


As for the dependent claims, these claims depend on Claim 13, they share its allowable features, and therefore it is respectfully submitted that they should be allowed as well.

In connection with the Examiner's formal objection to the drawings, applicant amended Claim 23. It is therefore believed that the changes of the drawings are no longer needed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,


Michael J. Striker
Attorney for Applicant
Reg. No. 27233